

### **REMARKS**

Applicant hereby confirms the election to pursue the claims of Group I, i.e. claims 1-11 and 14-16. Accordingly claims 12 and 13 have been withdrawn.

The Examiner has rejected claim 1 under 35 USC § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In this regard, Applicant has amended the claim to be directed to a method for automatically updating non-image information stored on an electronic memory device at a first location using a first image software application running on an associated computer. Claim 1, as amended, clearly sets forth appropriate structure for automatically updating an image that is stored on electronic memory device that is managed by a first image software application. Claim 1 further includes the providing of new information with respect to the digital image that occurs in a second image software application and wherein there is the automatic updating of the image information stored in the electronic memory device at the first storage location with respect to the new information. Applicant respectfully submits that claim 1 in its present form provides appropriate structure and means for accomplishing the method set forth in Applicant's invention. Accordingly, Applicant respectfully submits that claim 1 overcomes the rejection under 35 USC § 112 second paragraph.

The Examiner, in the Official Action, also rejected claims 1-11 and 14-16 under 35 USC § 103(a) as being unpatentable over Houchin et al. in view of Parks et al. for the reasons set forth therein. It appears that the Examiner has maintained the same rejections previously set forth in the original application, however, Applicant respectfully submits that the claims as currently set forth are clearly distinguishable over the cited prior art. As can be clearly seen, the present invention is directed to a method for automatically updating non-image information that is stored on an electronic memory device at a first location using a first image software application running on an associated computer. New information is provided with respect to the digital images in a second unrelated image software application. Thereafter the non-image information stored on the electronic memory device is updated with the new information that is obtained

utilizing the second unrelated image software application. As Applicant has pointed out in Applicant's previous response, the Houchin et al. reference is directed to a technique that tells a software application whether certain extensions are present and whether or not the extensions should be maintained or deleted if the base line data is modified by the application. Houchin et al. identifies the validity of an extension so that the ancillary data for a particular extension is maintained in the file if the extension is valid and removed from the file if the extension is invalid. See column 1, lines 61-64. There is no teaching or suggestion of providing new non-image information with respect to the digital images that is added to the existing information.

There is no teaching or suggestion in Houchin et al. of providing new information as taught and claimed by Applicant, or the automatically updating of the non-image information with the new information as taught and claimed by Applicant. The Examiner refers to column 1, lines 5-8 for the teaching of providing new information, however, this is contrary to what is stated in Houchin. More specifically, Houchin states at column 1, lines 8 and 9:

“technique that tells a software application whether extension data should be maintained or deleted if baseline data (image or non-image data) is modified by the application.”

This does not teach or suggest providing new non-image data, but whether something is to be maintained or deleted. Thus, the Houchin reference clearly does not teach or suggest at least this one claimed aspect.

The Examiner then refers to column 2, lines 54-56 and Figure 1 for illustrating the automatically updating the image at the first storage location with respect to said information. Column 2 of Houchin et al. states:

“In this embodiment, the elements of the file include a file header 11, baseline image data 13, baseline non-image data 15, followed by the extensions 12.”

There is no teaching or suggestion the automatically updating of anything in this passage. This merely describes the elements of the file.

The Examiner then relies on Parks et al. for disclosing automatically updating and then refers to column 10, lines 3-6. The Parks et al. reference is directed to a method of merging alphanumeric data stream with a digitized image file. This reference is directed to a data storage and retrieval system. As set forth at column 3, lines 4-11, the invention described therein is

directed to a means to process coded data along with image systems and the ability to process it either in the workstation with the additional capability of automatically merging the two on a display or printer bit plan if they have been logically related through recorder head information. This reference is merely directed to combining alphanumericics with images. There is no teaching or suggestion of having the first image at a storage location having non-image information which is updated with new information of the same image located at a remote site utilizing a second image software application.

As set forth in MPEP 706.02(j):

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §2143.03 for decisions pertinent to each of these criteria.

“The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’ *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.”

Thus, in order to make the combination suggested by the Examiner, there must be some suggestion or motivation to make the combination. The two cited references, Houchin et al. and Parks et al., are directed to two totally different aspects. There is no teaching or suggestion as to why one would combine one with the other. Furthermore, even when combined together, they must teach each and every element of the claimed invention. As previously discussed, the Houchin et al. reference fails to teach certain aspects discussed above. The Parks et al. reference fails to teach any further the missing limitations not shown by Houchin et al. Thus, even if the combination were made, they still

fail to suggest the present invention. Accordingly, Applicant respectfully submits that claim 1 and its dependent claims are patentably distinct for the reasons discussed above.

Claim 8, the second independent claim, is patentably distinct at least for the same reasons previously discussed with claim 1. In addition, claim 8 is directed to a situation where a third party is provided for providing new information with respect to information stored at a remote image server and that the third party utilizes an image software application running at the remote site which automatically updates the information stored at the first location with said new information. Applicant respectfully submits that the cited reference does not teach or suggest that the second application, where new information is provided, automatically updates the existing information stored at the first location as taught and claimed by Applicant. Thus, claim 8 is patentably distinct for this additional reason.

Claim 9 is dependent upon claim 8 and therefore is patentably distinct for the same reasons discussed therein.

Independent claim 10 is similar to claim 8 in that there is also provided access to a third party to a digital image stored at a remote image server and that the third party may provide new information in an image application software running at the image server that automatically updates information at the first location. The difference being in this particular claim is that there is a notification process for notifying the existence of the information to the first computer and then automatically updating if the user decides to do so. There is no teaching or suggestion in the cited art of notifying and automatically updating if the user decides to do so.

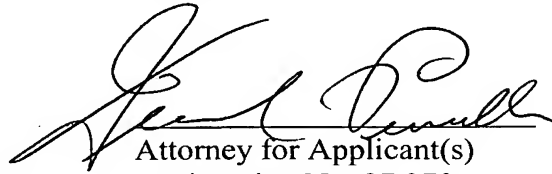
Claim 11 is another independent claim similar to claim 10 however, instead of being conducted at a server, it is conducted at a third party computer and therefore is patentably distinct for the same reasons discussed with independent claim 10.

The last independent claim 16, is directed again to a method for updating non-image information stored at an electronic memory device associated with a computer at a first location. This is similar to independent claim 8 wherein the new information is developed in a second application running at a remote

image server. Here again, this is patentably distinct for the same reasons previously discussed.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.